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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,932	10/30/2003	James F. McGuckin JR.	1255	1044
7590 NEIL D. GERSHON R&X MEDICAL 1011 HIGH RIDGE RD Stamford, CT 06905		05/04/2007	EXAMINER SHAFFER, RICHARD R	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 05/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/696,932	Applicant(s) MCGUCKIN ET AL.	
	Examiner Richard R. Shaffer	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/26/06; 1/29/07</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

The amended drawings filed on December 18th, 2006 are acknowledged and accepted by the examiner. The previous objections are hereby withdrawn.

Terminal Disclaimer

The terminal disclaimer filed on October 26th, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Applications 11/219,432; 10/805,796; 10/919,825; 10/638,846 and 10/697,211 and Patents 6,783,538 and 6,793,665 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

The amendments to the claims filed on October 26th, 2006 are acknowledged and accepted by the examiner. The previous rejections under 35 U.S.C. 112, first and second paragraph are hereby withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-4, 6, 7, 9, 11-14, 16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by van der Burg et al (US Patent 6,994,092).

Van der Burg et al disclose a device (**Figure 35**) and method (**Column 16, Line 51 through Column 18, Line 50**) comprising: a mounting section (straight portion of **220**) having a proximal and distal end; two filtering sections defined by the two spring regions (**17, 218**) found at either end (**190, 192**); the filtering sections created from a plurality of longitudinal struts (**220**) curved radially inward as well as axially inward; the device capable of being self-expanding (**See Column 12, Lines 41-60 and Column 17, Lines 58-61**); the struts are spaced circumferentially about 60 degrees apart (inherent from 6 equally spaced struts about a circle); a plurality of vessel engaging members (**195**); the device is made of Nitinol (**Column 12, Lines 52-60**); and the struts having a varying width along their length as easily shown in **Figure 30A** due to the branching of the vessel engaging members (**195**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over van der Burg et al in view of Bosma et al (US Patent 6,443,972).

Van der Burg et al disclose all of the claimed limitations except is silent as to whether the longitudinal struts are roughened. Bosma et al teach (**Column 6, Lines 52-**

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53) that simply coarsening the outer surface of the device can improve the retention of the device within a blood vessel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of van der Burg et al with a roughened outer surface as taught by Bosma et al in order to improve atraumatic retention within a blood vessel.

Claims 8, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over van der Burg et al in view of Gilson et al (US Patent Application Publication 2002/0058911).

Van der Burg et al disclose all of the claimed limitations except for struts out of phase as well as connecting ribs to adjacent longitudinal struts. Gilson et al teach in **Figures 15-22** out of phase struts and in **Figures 23-26** connecting ribs between struts. Within the specification, Gilson et al consider these structures mere embodiments and all function essentially the same with only the process of manufacture differing. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to also manufacture the device of Van der Burg et al with out-of-phase struts or interconnected struts given the preference or ease of manufacture as well as a general matter of design choice since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person having ordinary skill in the art would find obvious. *In re Dailey and Eilers*, 149 USPQ 47 (1966).

Response to Arguments

Applicant's arguments filed October 26th, 2006 have been fully considered but they are not persuasive. The examiner takes partial responsibility for previously stating that the recitation of self-expanding would be sufficient to overcome the prior art reference of van der Burg et al. However, as stated in the current Office Action, van der Burg et al does disclose the equivalence of expanding mechanisms and states that any of them can be used. In regard that both converging regions are not positioned radially and axially inward, Figure 35 clearly shows filtering sections having ends as "inward" as applicant's invention as well as an "end" of the filter located axially inward.

Conclusion

Since applicant was instructed that the proposed amendment would overcome the prior art reference of van der Burg et al, **this Office Action is made Non-Final.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer
April 29th, 2007



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER